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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/535,790	03/29/2000	Deirdre O'Shea	99-032	7017

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EXAMINER

YOUNG, JOHN L

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 05/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/535,790

Applicant(s)
O'Shea et al.

Examiner
John Young

Art Unit
3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 5, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-167 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-167 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-167 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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REQUIREMENT FOR ELECTION/RESTRICTION

1. Applicant is advised herewith that the reply to this requirement to be complete must include an election of one species is required because claim to a generic invention (genus) and claims to more than one patentably distinct species are claimed in the same application and because the search and examination of an unreasonable amount of species associated with 167 claims in the instant application cannot be made without serious burden. (See 37 CFR 1.141; 37 CFR 1.142; and 37 CFR 1.146). Applicant has one month to respond (See MPEP 809.02(a).

MPEP 803: RESTRICTION — When Proper

2. The following is a quotation of an informational statement about restriction requirements:

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 - § 806.04(I)) or distinct (MPEP § 806.05 - § 806.05(I)). If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

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37 CFR 1.142 Requirement for restriction:

If two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction (also known as a requirement for division). Such requirement will normally be made before any action on the merits; however, it may be made at any time before final action.

37 CFR 1.146 Election of species:

On an application containing a generic claim to a generic invention (genus) and claims to more than one patentably distinct species embraced thereby, the examiner may require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted if no claim to the genus is found to be allowable. . . .

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3. This application contains claims directed to the following patentably distinct species of the claimed invention:

Group I (claims 1-47, 48-57, 58-74, 87, 94-95, 144-153 & 162-167) is independent and distinct from Group II, Group III, Group IV, Group V, Group VI, Group VII, Group VIII, Group IX, Group X, Group XI, Group XII, Group XIII, Group XIV, Group XV, Group XVI, Group XVII, Group XVIII, and Group XIX. Group I is directed to “A method for changing a benefit associated with a coupon . . . establishing an initial benefit for a coupon . . . establishing a benefit variation condition for said coupon, said benefit variation condition having at least one associated qualifying action . . . receiving notice of a completion of said at least one qualifying action; and updating said coupon’s benefit in accordance with said benefit variation condition.” (NOTE: Even though claims 48-57 & 58-74 are independent from claims 1-47, said claims 1-47, 48-57 & 58-74 are obvious relative to each other; therefore not patentably distinct and fall in the same grouping.

Group II (claims 75, 86, 111 & 154-157) is independent and distinct from Group I, Group III, Group IV, Group V, Group VI, Group VII, Group VIII, Group IX, Group X, Group XI, Group XII, Group XIII, Group XIV, Group XV, Group XVI, Group XVII, Group XVIII, and Group XIX. Group II is directed to the redemption of a coupon.

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Group III (claim 76) is independent and distinct from Group I, Group II, Group IV, Group V, Group VI, Group VII, Group VIII, Group IX, Group X, Group XI, Group XII, Group XIII, Group XIV, Group XV, Group XVI, Group XVII, Group XVIII, and Group XIX. Group III is directed to crediting a financial account associated with a redeemed coupon.

Group IV (claims 77, 78, 79, 80, 82, 112-128 & 130) is independent and distinct from Group I, Group II, Group III, Group V, Group VI, Group VII, Group VIII, Group IX, Group X, Group XI, Group XII, Group XIII, Group XIV, Group XV, Group XVI, Group XVII, Group XVIII, and Group XIX. Group IV is directed to substantially registration of a duplicate coupon.

Group V (claims 81, 84 & 85) is independent and distinct from Group I, Group II, Group III, Group IV, Group VI, Group VII, Group VIII, Group IX, Group X, Group XI, Group XII, Group XIII, Group XIV, Group XV, Group XVI, Group XVII, Group XVIII, and Group XIX. Group V is directed to a coupon issuing system.

Group VI (claims 83 & 129) is independent and distinct from Group I, Group II, Group III, Group V, Group VII, Group VIII, Group IX, Group X, Group XI, Group

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XII, Group XIII, Group XIV, Group XV, Group XVI, Group XVII, Group XVIII, and Group XIX. Group VI is directed to the redemption of a duplicate coupon.

Group VII (claims 88, 89) is independent and distinct from Group I, Group II, Group III, Group IV, Group V, Group VI, Group VIII, Group IX, Group X, Group XI, Group XII, Group XIII, Group XIV, Group XV, Group XVI, Group XVII, Group XVIII, and Group XIX. Group VI is directed to a coupon.

Group VIII (claim 90) is independent and distinct from Group I, Group II, Group III, Group IV, Group V, Group VI, Group VII, Group IX, Group X, Group XI, Group XII, Group XIII, Group XIV, Group XV, Group XVI, Group XVII, Group XVIII, and Group XIX. Group VIII is directed to a coupon with an associated variation condition.

Group IX (claim 91) is independent and distinct from Group I, Group II, Group III, Group IV, Group V, Group VI, Group VII, Group VIII, Group X, Group XI, Group XII, Group XIII, Group XIV, Group XV, Group XVI, Group XVII, Group XVIII, and Group XIX. Group IX is directed to a coupon with an associated qualifying action.

Group X (claim 92) is independent and distinct from Group I, Group II, Group III, Group IV, Group V, Group VI, Group VII, Group VIII, Group IX, Group XI, Group

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XII, Group XIII, Group XIV, Group XV, Group XVI, Group XVII, Group XVIII, and Group XIX. Group X is directed to an electronic coupon.

Group XI (claim 93) is independent and distinct from Group I, Group II, Group III, Group IV, Group V, Group VI, Group VII, Group VIII, Group IX, Group X, Group XII, Group XIII, Group XIV, Group XV, Group XVI, Group XVII, Group XVIII, and Group XIX. Group XI is directed to an electronic coupon associated with one qualifying action.

Group XII (claims 96-106) is independent and distinct from Group I, Group II, Group III, Group IV, Group V, Group VI, Group VII, Group VIII, Group IX, Group X, Group XI, Group XIII, Group XIV, Group XV, Group XVI, Group XVII, Group XVIII, and Group XIX. Group XII is directed to a method for changing a benefit for a coupon.

Group XIII (claims 107-108) is independent and distinct from Group I, Group II, Group III, Group IV, Group V, Group VI, Group VII, Group VIII, Group IX, Group X, Group XI, Group XII, Group XIV, Group XV, Group XVI, Group XVII, Group XVIII, and Group XIX. Group XIII is directed to a method for changing a benefit for a coupon and receiving an indication of a change in the benefit.

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Group XIV (claims 109-110) is independent and distinct from Group I, Group II, Group III, Group IV, Group V, Group VI, Group VII, Group VIII, Group IX, Group X, Group XI, Group XII, Group XIII, Group XV, Group XVI, Group XVII, Group XVIII, and Group XIX. Group VI is directed to a method for redeeming a coupon.

Group XV (claims 131-135) is independent and distinct from Group I, Group II, Group III, Group IV, Group V, Group VI, Group VII, Group VIII, Group IX, Group X, Group XI, Group XII, Group XIII, Group XIV, Group XVI, Group XVII, Group XVIII, and Group XIX. Group XV is directed to a method of using a computer system for providing a coupon.

Group XVI (claim 136) is independent and distinct from Group I, Group II, Group III, Group IV, Group V, Group VI, Group VII, Group VIII, Group IX, Group X, Group XI, Group XII, Group XIII, Group XIV, Group XV, Group XVII, Group XVIII, and Group XIX. Group XVI is directed to an apparatus for providing a coupon having a variable benefit.

Group XVII (claim 137) is independent and distinct from Group I, Group II, Group III, Group IV, Group V, Group VI, Group VII, Group VIII, Group IX, Group X, Group XI, Group XII, Group XIII, Group XIV, Group XV, Group XVI, Group XVIII,

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and Group XIX. Group XVII is directed to “[a] coupon issuing system . . . wherein a duplicate of the coupon is transmitted. . . .”

Group XVIII (claims 138-143) is independent and distinct from Group I, Group II, Group III, Group IV, Group V, Group VI, Group VII, Group VIII, Group IX, Group X, Group XI, Group XII, Group XIII, Group XIV, Group XV, Group XVI, Group XVII, and Group XIX. Group XVIII is directed to “[a] method of using a computer for redeeming a coupon. . . .”

Group XIX (claims 158-161) is independent and distinct from Group I, Group II, Group III, Group IV, Group V, Group VI, Group VII, Group VIII, Group IX, Group X, Group XI, Group XII, Group XIII, Group XIV, Group XV, Group XVI, Group XVII, and Group XVIII. Group XIX is directed to “[a] system for changing a benefit associated with a coupon. . . .”

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-47 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon,

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including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Furthermore, The Examiner has determined that election of one species is required because search and examination of an unreasonable amount of species associated with 167 claims in the instant application cannot be made without serious burden.

RESPONSE TO ARGUMENTS

4. Applicant's arguments (Amendment A, paper#6, filed 03/05/2003) concerning the rejections in the prior Office Action have been considered but are not persuasive for the following reasons:

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Applicant's arguments are provisionally moot pending an election of species by Applicant. The Examiner has determined that election of one species is required because claim to a generic invention (genus) and claims to more than one patentably distinct species are claimed in the same application and because the search and examination of an unreasonable amount of species associated with 167 claims in the instant application cannot be made without serious burden.

CONCLUSION

5. Any response to this action should be mailed to:

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703) 746-7239 or (703) 872-9314 (for formal communications EXPEDITED PROCEDURE) or

(703) 746-7239 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

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Seventh floor Receptionist
Crystal Park V
2451 Crystal Drive
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.



John L. Young

Patent Examiner

May 13, 2003